



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/524,727 | 09/19/2005 | Donald McCallum | 129530.00201 | 8391 |

21269 7590 01/16/2009
PEPPER HAMILTON LLP
ONE MELLON CENTER, 50TH FLOOR
500 GRANT STREET
PITTSBURGH, PA 15219

| |
|----------|
| EXAMINER |
|----------|

LE, MARK T

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3617

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

01/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/524,727 | Applicant(s) MCCALLUM, DONALD | |
| | Examiner MARK T. LE | Art Unit 3617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7,8,10,13,17,19,21,24,26,27,31,34,35,38-40,43 and 46 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,7,8,24,26,27,31,34,35,38-40,43 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 13, 17, 19, 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/06;5/05;2/05</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Applicant's election with traverse of Group I, Species II, claims 1, 10, 13, 17, 19 and 21, in the reply filed on November 20, 2008 is acknowledged. The traversal is on the ground that the different inventions and species presented in the instant application can be searched and considered without a serious burden. This is not found persuasive because different search strategies and approaches would be used depending upon which invention and species are elected for the examination, and that the task of performing all of such different search strategies and approaches for the many different inventions and species of the instant application would present a serious burden in the examination process. As to the species election requirement, currently there is no evidence that the different species have the same or corresponding special technical or allowable feature; however, upon the allowance of a generic claim, application will be entitled to consideration of claims to the additional species which are written in dependent form or otherwise include all of the limitations of an allowable generic claim.

The requirement is still deemed proper and is therefore made FINAL.

2. The abstract of the disclosure is objected to because phrases that can be implied, such as "... is also described" in the last line of the abstract, should be avoided. Correction is required. See MPEP § 608.01(b).

3. Claims 10, 13, 17, 19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, line 4, "the rail of the railway track" lacks antecedent basis. It should be changed to -- a rail of the railway track --.

In claim 13, line 4, "the raised track" lacks antecedent basis. Correction is required.

Claim 17 is indefinite because it depends from an indefinite base claim.

In claim 19, the expression "guide means" is recited; however, it is not clear as to whether said expression is intended to invoke means plus function in accordance with 35 USC 112, sixth paragraph. Accordingly, the limitation associated therewith is currently not being treated as means plus function in accordance with 35 USC 112, sixth paragraph. Applicant is suggested to avoid using the word "means" in the claims if the 112, sixth paragraph is not intended.

In claim 21, lines 5-6, the words "thereto" (both occurrences) are not clear as to which structures are being referred to. They should be changed to -- the upper supporting member--.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 10, 13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Eddy (US 741,896).

Eddy discloses a turnout apparatus having all of the features as recited in the instant claims, including raised track surface 18 that is supported on upper supporting

member 5 that is positioned on top of the main railway track such that the raised track surface provides a path along which wheels of a train can travel from the main railway track to another railway track.

Regarding the instant claimed lower supporting member, as recited in instant claim 13, note that either one of the rails and/or ties underneath upper supporting member 5 of Eddy is readable as an lower supporting member.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy (US 741,896) in view of Kober (US 1,069,069) or Bridges (US 1,315,702).

Regarding the instant claimed pair of guide means projecting downwardly to straddle the rail of the railway track, note that such concept of using guide means to secure a supporting member from lateral movements is well known. Note for example, the guide means of either Kober (Figs. 2,3) or Bridges (Figs. 3,4) that are projecting downwardly to engage the rails of the railway track to secure the upper supporting member and the raised track from unwanted lateral movements. Therefore, it would have been obvious to one skilled in the art to provide guide means, similar to that of either Kober or Bridges, under supporting member 5 of Eddy so as to straddle the rail of the railroad track for enhancing the securement of the supporting member and the raised track from unwanted lateral movements.

8. Claims 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK T. LE whose telephone number is (571)272-6682. The examiner can normally be reached on Mon-Fri, between 8:15-4:45 (Teleworking).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Le/
Primary Examiner
Art Unit 3617

mle
1/12/09